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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,200	10/13/2005	Seigo Watanabe	279492US0PCT	1255
22850	7590	09/18/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
NGUYEN, CAM N				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
09/18/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/553,200

**Applicant(s)**

WATANABE ET AL.

**Examiner**

Cam N. Nguyen

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/09/09 (an RCE/amendment/response).  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4 and 6-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 4 and 6-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/888)  
Paper No(s)/Mail Date see the file.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Status of Continued Examination Application (RCE)

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 07/09/09 has been entered.

### Response to Amendment

2. The amendment filed on 07/09/09 has been made of record and entered. Claims 1-3 & 5 have been canceled. Claims 7-10 have been added.

Claims 4 & 6-10 are currently pending in this application for examination.

### Claim Rejections - 35 USC § 102(b)/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4 & 6-10** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sasaki et al., hereinafter referred to as "*Sasaki '765*", (US Pat. 4,978,765).

*Sasaki '765* discloses a fluidized bed catalyst which has a catalytic composition satisfying the following empirical formula:  $Q_qR_rMo_{10}Bi_aFe_bSb_cNi_dO_e(SiO_2)_f$  wherein Q represents P and/or B; R represents at least one alkali metal element selected from the group consisting of Li, Na, K, Rb and Cs; q, r, a, b, c, d, and f each represent atomic ratio of the element in the formula for which they are subscripts provided that q is 0 to 3, r is 0.01 to 1.5, a is 0.1 to 3, b is 0.1 to 2.5, c is at least 2 and not large than 15, d is 4 to 8, e is the number of oxygen atoms corresponding to the oxides formed by combining the above components together, and f is 20 to 150 (see col. 17- col. 18, claim 1).

Regarding claims 4 & 7-10, the limitation on "the catalyst comprises a bulk composition and surface composition...have a relationship such that B/A is not greater than 0.6" is noted. It is inherent and expected that the disclosed catalyst would have the same properties as being claimed because the catalyst has the same composition and atomic ratios as being claimed.

If in fact the disclosed catalyst does not have the same bulk composition and surface composition B/A atomic ratios, then the following applies.

It would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have optimized such atomic ratios in the catalyst of *Sasaki '765* in order to achieve an effective catalyst because it is a results-effective variable, in view of *of In re Boesch*.

Regarding claim 6, process limitations in the claim have been noted. While the product of the reference is not made by the same process, the product disclosed is the same as being claimed. It has been held that the patentability of the product and its method of production are separately determined. Thus, even though the process limitations in the claims are not disregarded, they have no bearing on the patentability of the claims product per se. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP 2113*.

#### **Response to Applicants' Arguments**

4. Applicants' remarks filed on 07/09/09 have been fully considered, but not deemed persuasive in view of the new ground of rejection(s) and/or objection(s) above and the following reasons.

Applicants' arguments regarding the differences in the process steps of preparing the catalyst between the claimed invention and the disclosed invention is noted. The instant claims are drawn to a "catalyst" and not a process of preparing a catalyst, applicants' arguments are not found persuasive. Since both the claimed catalyst and the disclosed catalyst have the same chemical composition, it is only reasonable to conclude that it is inherent and obvious that the disclosed catalyst would have the same B/A atomic ratios as claimed.

Applicants' Affidavit/Declaration filed on 07/09/09 is noted. The declaration has been reviewed and considered but it is not persuasive because atomic ratios is a results-effective variable it can obviously be optimized by a person having the ordinary skill in the art with a reasonable success of achieving an effective catalyst, since it has been held that discovering an

optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

#### Conclusion

5. Claims 4 & 6-10 are pending. Claims 4 & 6-10 are rejected. No claims are allowed.

#### Contacts

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner CAM N. NGUYEN, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Primary Examiner

Art Unit: 1793

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/C. N. N./

September 13, 2009